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09/524,826	03/14/2000	Paul C. Tang	310265.90261	7757

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EXAMINER

BUI, KIM T

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/524,826

Applicant(s)

TANG ET AL.

Examiner

Kim T. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become "ABANDONED" (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the amendment filed 6/6/2003. Claims 1-5, 14-16 are pending. Claims 1, 2, 3 have been amended. Claims 6-13 are cancelled. Claims 14-16 are newly added.

***Claim Rejections - 35 USC § 112***

2. The rejection of claims 1-13 under 35 U.S.C. 112, second paragraph, is hereby withdrawn due to the amendment filed 06/06/2003.

***Claim Rejections - 35 USC § 101***

3. The rejection of claims 6-13 under 35 U.S.C. 101 is hereby withdrawn due to the amendment filed 06/06/2003.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5 and newly added claim 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (6149585) for substantially the same reasons given in the previous Office Action (paper no. 4), incorporated herein, and further in view of Coli et al (6018713). Further reasons are given hereinbelow.

- (A) Claim 1 has been amended to recite "at least a single guideline", "associated with the single clinical guideline" and "the action item being process by the

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computerized patient record system to create an order". As per the single guideline, Gray discloses a plurality of guidelines, see Gray, col. 5, lines 17-26. This meets the single guideline. Gray discloses the guideline server, the user terminal with browser for viewing guideline and hyperlink for selection by the user. The user reviews the guideline and makes selection by clicking on the hyperlink. Upon the selections of the user, recommendation of procedure are presented and by accepting recommendation, service record can be created. See Gray, Figs 19-22A, col. 2, lines 41-42, line 65, col.3, lines 8-11, col. 4, line 41 to col.5, line 61, col. 6, lines 50-68, col. 8, lines 23- 26, lines 55-65, col. 9, line 40 to col. 10, line 18, col. 10, lines 53-61. According to Gray, possible diagnoses and hyperlinks are presented (Gray, Fig 21); upon user selections, recommendation task including test or procedure is presented (Gray, Fig 22, col.6, lines 50-65). The user can chose to accept this recommendation, and service record is created (Gray, col. 10, lines 14-15). Gray does not expressly recite that by invoking a hyperlink, the interpreter sends a communication to medical record software to cause an order to be entered. This, however, is well known as disclosed by Coli et al. Coli et al discloses a test and medical record system wherein a doctor activates hyperlink associated with a desired test for test ordering function. See Coli et al. col. 19, lines 54-63. It would have been obvious to one having ordinary skill in the art to include the medical record system with hyperlink for test ordering function disclosed by Coli et al. into Gray with the motivation of automating the test ordering function and facilitating the selection of tests and diagnoses in an organized fashion. See Coli et al. col. 12, lines 24-28.

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(B) Amendments to claim 3 were apparently made to overcome the 112, 2<sup>nd</sup> paragraph issues set forth in the prior Office Action (paper no. 4). However, these changes do not effect the scope and breadth of the claims as originally presented and/or in the manner in which the claims was interpreted by the Examiner. As such, the claim is rejected under the same rationale given in the prior Office Action (paper no. 4), incorporated herein, in view of the above rejection of the amended claim 1.

(C ) Claims 4,5 have not been amended and are rejected for the same reasons given in the prior Office Action (paper no. 4) in view of the above rejection of the amended claim 1.

(D) As per claim 14, Gray discloses a method in a medical record and diagnosis client-server computer system comprising the steps for:

(a) providing clinical guideline server for diagnosis for presenting text and hyperlink to the user for assisting and recommending diagnosis and test, procedure to be performed. See Gray, Figs 19-22A, col. 2, lines 41-42, line 65, col.3, lines 8-11, col. 4, line 41 to col.5, line 61, col. 6, lines 50-68 .

(b) providing client terminal including display with web browser for displaying clinical guidelines and hyperlinks. See Gray, Figs 19-22A, col. 8, lines 23- 26, lines 55-65, col. 9, line 40 to col. 10, line 18, col. 10, lines 53-61.

( c) the user click on the hyperlink to initiate his selection and upon his acceptance, an order or diagnosis test is posted to be performed by a selected radiologist or other specialist. See Gray, col.8, lines 23-26, fig. 19, col. 9, lines 43-55, col.10, lines 53-61.

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Gray does not explicitly disclose the interpreter to process to tag to present the hyperlink, but lines 50-53 and lines 61-68, col.2, Fig. 21 of Gray teach that the client receive the HTML documents from the server to present recommendation guideline information including hyperlink to the user for selection. It is apparent that HTML suggested by Gray requires embedded tag to instruct the browser to display the text or image in specified format including hyperlink as shown in the drawings, particularly Fig.19. With the HTML at the client terminal, one with ordinary skill in the art at the time of the invention would have found it obvious to incorporate appropriate translator or interpreter to present hyperlink with the motivation for facilitating the method for assisting physician to make better decision on treatment plan by proving faster access to needed information as well as to smoothen navigation through the presented information. Gray does not expressly recite that by invoking a hyperlink, the interpreter sends a communication to medical record software to cause an order to be entered This is, however, well known as disclosed by Coli et al. Coli et al disclose a test and medical record system wherein a doctor activates hyperlink associated with a desired test for test ordering function. See Coli et al. col. 19, lines 54-63. It would have been obvious to one having ordinary skill in the art to include the medical record system with hyperlink for test ordering function disclosed by Coli et al. into Gray with the motivation of automating the test ordering function and facilitating the selection of tests and diagnoses in an organized fashion. See Coli et al. col. 12, lines 24-28.

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6. Claim 2 and newly added claims 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (US 6149585) in view of Coli et al as applied to claims 1, 14 above, and further in view of DeLaHueraga (US 6408330).

(A) As per claims 2, 15, it is unclear that the collective teachings of Gray and Coli discloses the issuing of prescription. This, however, is suggested by DeLaHueraga . DeLaHueraga discloses a physician assistance healthcare apparatus including a link to pharmacy server, upon verification of an ordered prescription, dispensation is approved. See DeLaHueraga, col. 53, lines 1-19, Fig. 13C, Fig. 30. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the prescription feature disclosed in DeLaHueraga into the collective system of Gray and Coli with the motivation for providing the physician with a standard and effective healthcare assistance system since it is commonly known for a physician to give prescription besides medical tests to effectively treat a patient.

(B) As per claim 16, Gray and Coli et al teach the order service is a medical test or procedure. See Gray, Fig 22, 22B and Coli et al., col. 1, lines 7-8, col. 19, lines 54-65.

### ***Response To Arguments***

7. Applicant's arguments filed 06/06/2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below.

(A) On page 1 of the remarks, Applicant argues that Gray does not describe medical records system. In response, the Examiner respectfully submit that Gray's system includes both a) diagnosis assisting by the use of clinical guidelines as disclosed in

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Gray, col. 5 line 5 to col. 6, line 25 and b) patient record keeping as disclosed in Gray, Fig. 11, col. 8, lines 53-59.

(B) On page 2 of the Remarks, Applicant argues the issue of obviousness. In response, it is the Examiner's position that since the present application is directed to document or records processing via a web browser within the healthcare industry, one having the level of ordinary skill in the art, therefore, is presumed to know both healthcare record processing and general HTML document processing, as well. One having ordinary skill in the art of HTML document processing at the time of the invention would have readily recognized that HTML document require embedded tags as well as translator/interpreter to present text, image or hyperlink to the user. Furthermore, the issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies



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to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest. The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior Office Action (paper no. 4) in view of the above rejection.

(C) In the second paragraph of page 2 of the Remarks, the Applicant argues that "order" has specific meaning. In response, it is the Examiner's position that it is unclear what is "the specific meaning of order" alleged by the Applicant, since Applicant fails to point to a strict definition within the specification or recite in the body of claim the specific meaning of the term "order" as intended by the Applicant. Further, the Examiner respectfully submits that Applicant fails to utilize claim language that invokes 35 U.S.C. 112, sixth paragraph (e.g., "means for ordering").

It is noted that a claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (a) the claim limitations must use the phrase "means for " or "step for ";
- (b) the "means for " or "step for " must be modified by functional language;
- and
- (c) the phrase "means for " or "step for " must not be modified by sufficient

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structure, material or acts for achieving the specified function.

With respect to the above 3-prong analysis, see *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000); *Masco Corp. v. United States*, 303 F.3d 1316, 1327, 64 USPQ2d 1182, 1189 (Fed. Cir. 2002); *York Prod., Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1574, 40 USPQ2d 1619, 1624 (Fed. Cir. 1996); *Caterpillar Inc. v. Detroit Diesel Corp.*, 41 USPQ2d 1876, 1882 (N.D. Ind. 1996) ; *Al-Site Corp. v. VSI International Inc.*, 174 F.3d 1308, 1318, 50 USPQ2d 1161, 1166-67 (Fed. Cir. 1999); *O.I. Corp.*, 115 F.3d at 1583, 42 USPQ2d at 1782 ; *Seal-Flex*, 172 F.3d at 849, 50 USPQ2d at 1234 (Radar, J., concurring); *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 54 USPQ2d 1449 (Fed. Cir. 2000); *Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d 1294, 1303-04, 50 USPQ2d 1429, 1435-36 (Fed. Cir. 1999); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531, 41 USPQ2d 1001, 1006 (Fed. Cir. 1996); *Unidynamics Corp. v. Automatic Prod. Int 'l*, 157 F.3d 1311, 1319, 48 USPQ2d 1099, 1104 (Fed. Cir. 1998) and MPEP § 2181. As such, the term "order" is subject to its "broadest reasonable interpretation", and not to any unique definition Applicant currently argues. To this end, concerning the "order" recited by the Applicant in claims 1-3, 14-16, it is the Examiner's position that Gray discloses the medical procedure and the service order, see Gray, Fig. 22, col. 10, lines 14-18, Coli et al discloses the activation of hyperlink for test ordering function, see Coli et al, col.1, lines 7-8, col. 19, lines 54-65, and an ordered prescription is disclosed in DeLaHueraga, see DeLaHuaega, col. 53, lines 1-19, Fig. 13C and Fig. 30.

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(D) Finally, it is noted that the claims are now rejected as being obvious under 35 U.S.C. 103 based on the combination of references Gray in view of Coli. et al. in response to the Applicant's amendment. As such, arguments concerning Gray alone are moot.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. " Method for database address specification" (6516321);"Order entry system for the Internet " (58843098);" OFF THE CHARTS AN ELECTRONIC MEDICAL RECORDS SYSTEM AT THE UNIVERSITY OF ILLINOIS MEDICAL CENTER.....TECHNOLOGY BELIEVERS", Koch, Christopher, Feb 1 2003, CIO, PP;46-50, Dialog File 15, Acc. 02538012.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 703-305-5874.

The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



KTB

August 25, 2003

  
JOSEPH THOMAS  
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